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REMARKS

The Examiner has rejected Claims 1, 4-6 and 10 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner has argued that “[a]s a result of Applicant’s remarks (pg. 8, paragraph 4) filed 10/17/2005 Examiner is now unclear exactly what limitations are intended by the recitation of ‘sending a tag indicative of availability of said updated computer file to said database of computers.’” Applicant respectfully asserts that Claim 1 has been amended for clarification purposes in order to overcome such rejection.

The Examiner has rejected Claims 1, 2, 4, 7, 10-12, 14, 17, 20-22, 24, 27 and 30 under 35 USC §103(a) as being unpatentable over Cheng (U.S. Patent 6,151,643) in view of Averbuch et al. (U.S. Patent 5,896,566) in further view of Neal (U.S. Patent 6,192,518). Applicant respectfully disagrees with such rejection, especially in view of the amendments made hereinabove to each of the independent claims.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant’s disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir.1991).

With respect to the third element of the *prima facie* case of obviousness, and in response to applicant’s latest arguments and amendments, the Examiner has failed to respond to applicant’s arguments that “Neal, in combination with the remaining references, fails to even suggest a version level tag sent to the database of computers in

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an e-mail message header, as claimed.” Applicant respectfully asserts that Col. 5, lines 11-13 in Neal, as relied on by the Examiner to meet applicant’s claimed technique “wherein said tag is part of an e-mail message header,” only generally teaches “messages that contain the ‘MBA 2.0’ tag in the subject text of the e-mail messages in the in-box.”

Furthermore, with respect to the first element of the *prima facie* case of obviousness, applicant notes that the Examiner has argued that it would have been obvious to a person of ordinary skill in the art at the time of the invention to provide each of Cheng’s client computers with the automatic detection and response aspects of Neal’s invention, thereby removing any reliance on users to perform the updates in a timely manner and ensuring uniformity on the client side as is desirable. Applicant respectfully disagrees. In particular, applicant points out that, in Neal, only an extremely short string of characters, which represents the tag, is included in the subject text, namely “MBA 2.0.” Cheng, on the other hand, discloses an “email [that] contains information about the software update...includ[ing] the record from the update table 807 about the software update, including URL data...[and] a specification of conditions a client computer 101 must satisfy for the software update...to be installed” (see Col. 20, lines 1-32).

Clearly, the vast amount of information Cheng required to be in the e-mail (i.e. record from the update table including URL data, conditions, etc.) would not be capable of being contained in the “subject text” of Neal, or in any subject text, for that matter. Applicant emphasizes that Cheng teaches records in the update table including “version information, file formats, configuration information, and network location” (see Col. 4, lines 51-60). Clearly, such record data, URL data, and conditions data, as described in Cheng as being included in the e-mail, could not be effectively contained in subject text of an e-mail, as taught in Neal. In view of such, Neal and Cheng would create an unworkable combination, contrary to the Examiner’s arguments.

Thus, applicant respectfully asserts that at least the first and third elements of the *prima facie* case of obviousness have not been met, for the above reasons. Nevertheless, despite such paramount deficiencies and in the spirit of expediting the prosecution of the

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present application, applicant has at least substantially included the following highlighted claim language in each of the independent claims:

- “(i) providing an updated version of said computer file at a location from which it may be downloaded by said computer;
 - (ii) sending a tag indicative of availability of said updated computer file to said database of computers utilizing email addresses associated with computers in said database such that said tag is sent to said computers in said database utilizing said email addresses; and
 - (iii) maintaining said database of computers to which said tag is to be sent when an updated version of said computer file is made available, wherein said database of computers includes priority data indicating a priority level associated with an address, said priority level being used to control how rapidly after said updated version of said computer file is made available said tag is sent to said database of computers, said priority level controlling selection of one of a plurality of different finite delay periods after said updated version of said computer file is made available following which said tag is sent to said database of computers;
- wherein said tag includes data indicative of a version level of said computer file, data indicative of a version level of a software program associated with said computer file, and data indicative of a version level of an engine associated with said software program;
- wherein said tag is encrypted;
- wherein said tag is part of an e-mail message header;
- wherein sending said tag to said database of computers further comprises:
- transmitting said tag through at least one local server and at least one mail gateway connected to said computers in said database such that said at least one local server reads said tag to determine if said data indicative of said version level of said computer file is more recent than a second version level of a computer file located on said at least one local server, and further such that said at least one mail gateway reads said tag

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to determine if said data indicative of said version level of said computer file is more recent than a third version level of a computer file located on said at least one mail gateway;

if said tag includes data indicative of a more recent version level than said second version level of said computer file located on said at least one local server, said at least one local server initiating a download of said computer file associated with said tag; and

if said tag includes data indicative of a more recent version level than said third version level of said computer file located on said at least one mail gateway, said at least one mail gateway initiating a download of said computer file associated with said tag” (see the same or similar, but not necessarily identical language in each of the independent claims).

Applicant respectfully asserts that simply nowhere in the prior art is there any disclosure of a tag in the specific context presently claimed by applicant. Furthermore, the prior art also fails to even suggest such tag being utilized by a local server and a mail gateway during its transfer to a computer, as now claimed. A notice of allowance or a specific prior art showing of all of such limitations, in combination with the remaining claim elements, is respectfully requested.

Still yet, applicant brings to the Examiner's attention the subject matter of new Claims 31-33 below, which are added for full consideration:

“wherein said tag further includes parameter data indicating options previously applied to said e-mail message” (see Claim 31);

“wherein said parameter data indicates scan options previously applied to said e-mail message including at least one of scan all files, scan utilizing macro heuristics, and scan utilizing all heuristics” (see Claim 32); and

“wherein each computer that receives said tag determines whether said

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data indicative of said version level of said computer file is more recent than said version level of a computer file located on said each computer, such that if said data indicative of said version level of said computer file is more recent, said each computer that receives said tag further determines whether said data indicative of said version level of said computer file is larger than a threshold number of versions ahead of said version level of said computer file located on said each computer, and if said threshold is met, said message is identified as possibly malicious and said e-mail message is scanned by said each computer" (see Claim 33).

Thus, all of the independent claims are deemed allowable. Moreover, the remaining dependent claims are further deemed allowable, in view of their dependence on such independent claims.

In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 505-5100. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 50-1351 (Order No. NAI1P474/01.112.01).

Respectfully submitted,

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